

## **REMARKS/ARGUMENTS**

The specification, claims, and drawings have been amended herein to clarify the invention. In general terms, a "refill" is a prescription drug that is provided again. Well known in the art, there are two ways a subsequent prescription drug can be provided to a patient. One is where the subsequent prescription drug is a continuation of an existing prescription, which is better known in the art as a refill. Another is where the subsequent prescription drug is provided to the patient once a prescription has no refills or the prescription has expired. This is also known in the art as a refill, but it is better known and more clearly identified in the art as a renewal prescription. Although the renewal prescription is a continuation of a previously prescribed therapy, it is generally treated as a new prescription which requires physician approval and authorization before a pharmacy can provide the subsequent prescription drug to the patient.

In the original specification, the Applicant refers to the renewal process using language such as: "refill of a filled prescription" (page 7, line 2, claims 1-3); "patients require refills of prescription drugs after the patient has completely filled the prescription" (page 30, line 5); "where the status field 316...indicates that the prescription has been entirely filled, only then will the prescription refill section 312 be visible to the pharmacist or health care providers" (page 34, line 3); "refill request information and an authorization are received by the host system 12 for producing a 'new' prescription based on a filled prescription stored on the host system 12" (page 34, line 17); "[t]he health care provider reads the refill request information and then authorizes the refill" (page 37, line 16); and "new refill" (Figs. 6-8). One of ordinary skill in the art would understand based on the usage of the term "refill" by the Applicant in the above manners to refer to the "renewal"

process. However, to better clarify the invention, the Applicant has amended the specification, claims, and drawings, as described herein, to use the term "renewal" (and "renewed") when referring to a situation, and associated elements of the invention, where the subsequent prescription is based on a prescription that has been filled and has no refills or that has expired.

Claims 2 and 3 have been further amended to clarify the "authorization" as authorizing the requested renewal (refill) of the filled prescription, such as done in the original claim 1.

Therefore, it is respectfully submitted that the amendments provided herein to the drawings, specification, and claims are proper and do not constitute new matter. That is, the amendments to the specification, claims, and drawings are merely to make more explicit that which is implicit, inherent, or intrinsic from an overall view of the specification, claims, and drawings as originally submitted and should be entered into the patent application.

In view of the foregoing amendments to the specification, claims, and drawings, and the following arguments, it is respectfully submitted that the claims are now in condition for allowance.

**Rejection of Claims 1-3 under 35 U.S.C. §103(a)**

Claims 1-3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,202,923, issued to Boyer et al, in view of U.S. Patent No. 6,493,427, issued to Kobylevsky et al. Contrary to the Examiner's position, it is respectfully submitted that Boyer and Kobylevsky, whether viewed alone or in combination, do not teach, disclose, or even suggest a method for permitting a pharmacist to verify a renewal of a filled prescription stored on a host system as recited in Applicant's independent claims 1 and 2, as amended, or a method for permitting a health care provider to verify a renewal of a filled prescription stored on a host system as recited in Applicant's independent claim 3, as amended. More specifically, neither Boyer nor Kobylevsky teach, disclose, or suggest providing electronically a prescription renewal screen by a third party host system to a pharmacy system, receiving renewal request information from the pharmacy system, transmitting the renewal request information through the host system to a health care provider system, receiving by the host system an authorization authorizing the requested renewal of the filled prescription from the health care provider system, and transmitting by the host system the authorization to the pharmacy system as recited in Applicant's amended independent claim 1. Neither Boyer nor Kobylevsky teach, disclose, or suggest a method for permitting a pharmacist to verify a renewal of a filled prescription stored on a host system by providing electronically a prescription renewal screen by a third party host system to a pharmacy system, receiving renewal request information from the pharmacy system and a prescription renewal authorization authorizing the requested renewal of the filled prescription obtained from a health care provider, and generating a verification of the requested renewal by the host system including a unique prescription identification code

as recited in Applicant's amended independent claim 2. Also, neither Boyer nor Kobylevsky teach, disclose, or suggest a method for permitting a health care provider to verify a renewal of a filled prescription stored on a host system by providing electronically a prescription renewal screen by a third party host system to a health care provider system, receiving renewal request information from the health care provider and a prescription renewal authorization authorizing the requested renewal of the filled prescription, and generating a verification of the requested renewal by the host system including a unique prescription identification code as recited in Applicant's amended independent claim 3.

Boyer teaches a method and automated pharmacy to improve the workflow of medication dispensing and reduce errors during the filling of prescriptions by utilizing a pharmacy management system having a data entry workstation for processing data relating to a prescription, a filling workstation for dispensing a drug type in a container, a checking workstation where a pharmacist checks and validates that the correct prescription has been dispensed, a counseling workstation for providing information to a customer, and a point-of-sale workstation for providing a prescription to a customer and receiving payment therefor. Although Boyer teaches that a physician can provide the prescription to a data entry technician via telephone so that the data entry technician can enter prescription data into the data entry workstation, Boyer does not disclose (a) electronically transmitting renewal request information through a third party host system from a pharmacy system to a health care provider system and authorization from the health care provider system to the pharmacy system, as recited in Applicant's amended independent claim 1; (b) electronically receiving renewal request information from a pharmacy system and prescription renewal authorization from a health care provider by a third party host system

which generates a verification of the requested renewal that includes a unique prescription identification code, as recited in Applicant's amended independent claim 2; or (c) electronically receiving renewal request information and prescription renewal authorization from a health care provider by a third party host system which generates a verification of the requested renewal that includes a unique prescription identification code, as recited in Applicant's amended independent claim 3.

Kobylevsky teaches a system having a central station for receiving telephone calls forwarded by a pharmacy or prescriptions and orders over the Internet. Once a customer or doctor contacts the central station (via telephone or the Internet), the central station prompts the customer for prescription refill information, or the doctor for prescription information, and/or messages, and then transmits the information and/or messages to the pharmacy by facsimile, email, voice mail, or pager. Kobylevsky does not teach (a) electronically transmitting renewal request information through a third party host system from a pharmacy system to a health care provider system, as recited in Applicant's amended independent claim 1; (b) electronically receiving renewal request information from a pharmacy system and prescription renewal authorization from a health care provider by a third party host system which generates a verification of the requested renewal that includes a unique prescription identification code, as recited in Applicant's amended independent claim 2; or (c) electronically receiving renewal request information and prescription renewal authorization from a health care provider by a third party host system which generates a verification of the requested renewal that includes a unique prescription identification code, as recited in Applicant's amended independent claim 3.

In support of the rejection of claim 1, the Examiner stated that "Boyer discloses a method for permitting a pharmacist to verify a refill of a filled prescription stored on a host system comprising the steps of providing a prescription refill screen by the host system to a pharmacy system associated with the pharmacist, the prescription refill screen being associated with the filled prescription (Col. 5, lines 8-67 to Col. 6, line 32)". Applicant respectfully traverses Examiner's assertion that Boyer discloses 1) providing a prescription refill screen by the host system to a pharmacy system, and 2) that the prescription refill screen is associated with the filled prescription.

First, Boyer teaches that the data entry workstation contains data entry software which is a part of the pharmacy management system software and is made available to the data entry workstation through use of a screen window within which an interface to the pharmacy management software is presented, or through an electrical switching device which switches the pharmacy management system computer display, keyboard and mouse to or from the workstation (col. 5, lines 21-31). As such, the data entry workstation screen window is provided by the pharmacy management system and not by a third party host system, as required in Applicant's amended independent claim 1. Secondly, the data entry screen is not associated with the filled prescription. Boyer teaches that the data entry technician enters into the data entry workstation the information received from the prescription and from the patient, which "*at a minimum*" contains the patient's name and address, the physician's name, type of drug, dosage size of the drug, the quantity of drug, the date prescribed, instructions, number of refills allowed, and whether generic substitutions are permitted by the physician (col.6, lines 21-32). Thus, the data entry screen is associated with new prescriptions and not filled prescriptions.

Also, with regard to claim 1, the Examiner stated that "Boyer discloses... receiving refill request information from the pharmacy system, the refill request information identifying a requested refill of the filled prescription (Col. 6, lines 5-67); transmitting the refill request information through the host system to a health care provider system associated with a health care provider identified by the filled prescription stored on the host system (Col. 6, lines 1-67)." Applicant respectfully traverses Examiner's assertion that Boyer discloses receiving refill request information identifying a requested refill of the filled prescription from the pharmacy system and transmitting refill request information through the host system to a health care provider system. Boyer teaches that the prescription is provided by the patient via "personal delivery" within the pharmacy or drive-in window, or by telephone, to the data entry technician or workstation, or directly to the data entry technician by the physician via telephone, fax, or other method (col. 6, lines 6-20, and Figure 1). The data entry workstation of Boyer transmits all information via a database only to the other workstations within the pharmacy management system (col. 6, line 49-51). Thus, the data entry technician and/or workstation does not provide renewal request information identifying a requested renewal of the filled prescription, but rather only receives prescription information from the patient or physician and transmits the received prescription information internally within the pharmacy system to other workstations so that the prescription can be filled. Therefore, the Boyer pharmacy management system does not provide renewal request information identifying a requested renewal of the filled prescription which is received and transmitted through the third party host system to a health care provider system, as required in Applicant's amended claim 1.

As the Examiner has stated, "Boyer does not explicitly disclose receiving, by the host system, an authorization from the health care provider system...transmitting, by the host system, the authorization to the pharmacy system..." However, the Examiner asserts:

"these features are known in the art, as evidenced by Kobylevsky. In particular, Kobylevsky suggest receiving, by the host system, an authorization from the health care provider system... transmitting, by the host system, the authorization to the pharmacy system...(Col. 7, lines 10-67 to Col.8, line 34 and Col. 29, lines 9-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Kobylevsky with the Boyer's system with the motivation of providing the prescription which is authorized to be refilled."

Applicant respectfully traverses Examiner's assertion that Boyer or Kobylevsky provide a motivation for modifying Boyer with the teachings of Kobylevsky to arrive at the present invention. Even assuming that it would be obvious to modify Boyer with Kobylevsky, in addition to the other deficiencies of Boyer as discussed above, such a combination would not result in the invention recited in Applicant's amended claim 1. Therefore it is Applicant's position that all of the limitations of amended claim 1 are not found in the combination of Boyer and Kobylevsky.

In support of the rejection of claim 2, the Examiner stated that "Boyer discloses a method for permitting a pharmacist to verify a refill of a filled prescription stored on a host system comprising the steps of: providing a prescription refill screen by the host system to a pharmacy system associated with the pharmacist, the prescription refill screen being associated with the filled prescription (Col. 5, lines 8-67 to Col. 6, line 32); receiving request information from the pharmacy system, the refill request information identifying a requested refill of the filled prescription, and a prescription refill authorization obtained from a health



care provider (Col. 6, lines 5-67)." Applicant respectfully traverses Examiner's assertion that Boyer discloses 1) providing a prescription refill screen by the host system to a pharmacy system, 2) that the prescription refill screen is associated with the filled prescription, 3) receiving request information identifying a requested refill of the filled prescription from the pharmacy system, or 4) receiving a prescription refill authorization from the health care provider.

As discussed above with regard to claim 1, Boyer teaches that the data entry workstation screen window is provided by the pharmacy management system and not by a third party host system, as required by Applicant's amended claim 2. Boyer also teaches that the data entry screen is associated with new prescriptions and not filled prescriptions (as discussed above), as required by Applicant's amended claim 2. In Boyer, the data entry technician and/or workstation of the pharmacy management system receives prescription information from the patient or physician and transmits the received prescription information internally within the pharmacy system so that the prescription can be filled, and therefore does not provide renewal request information identifying a requested renewal of the filled prescription which is received and transmitted through the third party host system to a health care provider system, as required in Applicant's amended claim 2. Further, Boyer does not teach receiving the authorization from the health care provider system authorizing the requested renewal of the filled prescription, as required by Applicant's amended claim 2.

As the Examiner has stated, "Boyer does not explicitly disclose generating a verification of the requested refill by the host system including a unique prescription identification code identifying the requested refill..." However, the Examiner asserts:

"this feature is known in the art, as evidenced by Kobylevsky. In particular, Kobylevsky suggests a verification of the requested refill by the host system including a unique prescription identification code identifying the requested refill... (See Kobylevsky Col. 7, lines 1-67 to Col8, line 34 and Col. 29, lines 9-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Kobylevsky with the Boyer's system with the motivation of providing the prescription which is authorized to be refilled."

Applicant respectfully traverses the Examiner's assertion that Kobylevsky suggests generating a verification of the requested refill by the host system including a unique prescription identification code identifying the requested refill, or that Boyer or Kobylevsky provide a motivation for modifying Boyer with the teachings of Kobylevsky to arrive at the present invention. Kobylevsky teaches that "[t]he program requires that the number of digits in the Rx Number *used in the Pharmacy... be specified*" by the customer (col. 7, line 57-60, emphasis added). As best understood, Kobylevsky teaches that the Pharmacy, and not the program, supplies the digits in the Rx Number. The Pharmacy or customer can enter the Rx Number into the program to identify a prescription. However, Kobylevsky does not teach that a verification of the requested renewal is generated by the host system, or that the host system generates a unique prescription identification code identifying the requested renewal, as required in Applicant's amended claim 2. All of the limitations of amended claim 2 are not found in the combination of Boyer and Kobylevsky.

In support of the rejection of claim 3, the Examiner stated:

"Boyer discloses a method for permitting a health care provider to verify a refill of a filled prescription stored on a host system comprising the steps of: providing a prescription refill screen by the host system to a health care provider system associated with the health care provider, the prescription refill screen being associated with the filled prescription (Col. 5, lines 8-67

to Col. 6, line 32); receiving request information from the health care provider, the refill request information identifying a requested refill of the filled prescription, and a prescription refill authorization (Col. 6, lines 5-67)."

Applicant respectfully traverses the Examiner's assertion that Boyer discloses 1) providing a prescription refill screen by the host system to a health care provider system, and 2) that the prescription refill screen is associated with the filled prescription.

First, as discussed above, Boyer teaches providing a data entry screen window to the data entry workstation using the software of the pharmacy managements system associated with the pharmacy. Further, in the method taught by Boyer, the pharmacy management system does not provide anything to the physician, but rather only receives data from the physician when the data entry technician is "provided with prescription 2 directly by physician 61... via telephone 18, fax, or other method." Thus, in Boyer, no third party host system is taught and the data entry screen window is provided to the pharmacy and not the health care provider. Therefore, Boyer does not teach the step of providing a prescription renewal screen by a third party host system to a health care provider system, as recited in Applicant's amended claim 3. Further, as discussed above with regard to claims 1 and 2, Boyer teaches that the data entry screen is associated with new prescriptions and not filled prescriptions, as required by Applicant's amended claim 3.

As the Examiner has stated, "Boyer does not explicitly disclose generating a verification of the requested refill by the host system including a unique prescription identification code identifying the requested refill..." However, the Examiner asserts:

"this feature is known in the art, as evidenced by Kobylevsky. In particular, Kobylevsky suggests a verification of the requested refill by the host system including a unique prescription identification code identifying the requested refill..."

(See Kobylevsky Col. 7, lines 1-67 to Col8, line 34 and Col. 29, lines 9-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Kobylevsky with the Boyer's system with the motivation of providing the prescription which is authorized to be refilled."

Applicant respectfully traverses Examiner's assertion that Kobylevsky suggests the step of generating a verification of the requested refill by the host system including a unique prescription identification code identifying the requested refill, or that Boyer or Kobylevsky provide a motivation for modifying Boyer with the teachings of Kobylevsky to arrive at the present invention. As discussed above with regard to claim 2, as best understood, Kobylevsky teaches that the Pharmacy, and not the program, supplies the digits in the Rx Number which is used by the Pharmacy or customer to enter into the program to identify a prescription. Kobylevsky does not teach that a verification of the requested renewal is generated by the host system, or that the host system generates a unique prescription identification code identifying the requested renewal, as required in Applicant's amended claim 3. Therefore, even if it would be obvious to modify Boyer with Kobylevsky, the combination would not result in the invention recited in Applicant's amended claim 3. All of the limitations of amended claim 3 are not found in the combination of Boyer and Kobylevsky.

In summary, from the above it becomes apparent that the method for automating a pharmacy as taught by Boyer, and the system for receiving prescription orders for a pharmacy as taught by Kobylevsky are different than Applicant's inventive concepts of

verifying a renewal of a filled prescription stored on a host system as recited in Applicant's amended independent claims 1, 2, and 3. In view thereof, Applicant respectfully request reconsideration and withdrawal of the rejection of independent claims 1, 2, and 3 under 35 U.S.C. §103(a) as being unpatentable over Boyer in view of Kobylevsky.

### Conclusion

In view of the above, Applicant respectfully submits that this application, as now amended, is in condition for allowance for the reasons stated above. Therefore, it is requested that the Examiner reconsider each and every rejection as applicable to the claims now pending and issue a Notice of Allowance thereof.

This is intended to be a complete response to the Office Action mailed January 15, 2003. Should the Examiner have any questions regarding this Amendment, or the remarks contained herein, Applicant's attorney would welcome the opportunity to discuss such matters with the Examiner.

Respectfully submitted,



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